

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

RECEIVED
CENTRAL FAX CENTER
FEB 16 2007

REMARKS

Claims 1, 2, and 6-25 are all the claims presently pending in the application.

Claims 2, 7-11, 17, 22, and 23 are allowed. Claims 1, 6, 12-16, 18-21, and 24-25 stand rejected.

More specifically, claims 1 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over JP 07-160203 to Satoru, et al., further in view of US Patent No. 6,259,423 to Tokito, et al. Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Satoru/Tokito, further in view of US Patent No. 6,339,696 to Chan, et al. Claim 12 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Satoru/Tokito/Chan, further in view of US Patent No. 6,144,358 to Narayanaswamy, et al. Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Satoru/Tokito, further in view of US Patent No. 5,075,686 to Shigemura. Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Satoru/Tokito/Shigemura, further in view of Narayanaswamy. Claims 14-16 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Tokito, further in view of Narayanaswamy. Claims 18 and 19 stand rejected under 35 USC §103(a) as unpatentable over Satoru/Tokito, further in view of US Patent 6,144,296 to Ishida et al. Claim 20 stands rejected under 35 USC §103(a) as unpatentable over Satoru/Tokito/Ishida, further in view of Narayanaswamy.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a vehicle-mounted apparatus. A first panel includes a first display on a front surface thereof. A back surface of the first panel is substantially directly mountable onto a surface of the vehicle and affixed thereto in a manner such that the first display is viewable by a user. A second panel includes a second display and is openable and closeable with respect to the first panel about a side thereof as an axis.

Advantages of the present invention over prior art configurations include that of providing a display/control apparatus that minimizes space and reduces complexity for the control switching.

Moreover, relative to the device taught in primary reference Satoru, the present invention provides a simple mounting technique (e.g., substantially directly to the surface)

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

that does not require costly and complex motor-driven linkages and mechanism. Additionally, in an exemplary embodiment, the present invention provides a control panel on the back face of the second panel, thereby allowing more space on each panel to be devoted to the display function and, in one exemplary embodiment, provides a display configuration in which a portion of the first panel can be left uncovered when the second panel is in the closed position, thereby allowing the exposed portion of the first panel to serve as a small display area even when the panels are fully closed, relative to each other.

II. THE PRIOR ART REJECTIONS

Applicants gratefully acknowledge the Examiner for taking time from his busy schedule on February 5, 2007, to conduct a personal interview with applicants' representative. It is felt that this interview expedited prosecution by clarifying the Examiner's position that the present invention defined by claims 1, 6, 12-16, 18-21, 24, and 25 is considered not patentable over the prior art currently of record.

During this interview examiner Shapiro relied upon wording from the holding of *In re Keller*: "*But one can not show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.*"

Applicants, however, submit that the fact pattern of this case differs from that of the present prosecution and that these words are not applicable to the present prosecution.

In *Keller*, the court specifically held that the rejection met the initial burden of *prima facie* obviousness rejection by having properly combined secondary analogous art. The issue in the *Keller* case, boiled down to the novelty of replacing an RC timer in a cardiac pacer by a digital timer, as described in the secondary reference considered as related to a cardiac pacer.

The wording upon which the Examiner relies relates to an affidavit that the appellant had introduced during prosecution from an expert Dr. Cywinski, who provided his opinion in the affidavit relative to only one of the two references that had been combined with a rejection. The wording in the holding simply relates to the fact that the affidavit addressed only one of these two references and did not address the secondary reference directed to a digital timer.

Thus, the Court in *Keller* was not attempting to change the initial burden of an Examiner to establish a *prima facie* rejection when two references are combined. Rather, the

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

Court was stating that, once the burden had shifted back to an applicant, the applicant would not have successfully met the burden in response by addressing only one of the two references, thereby failing to address the combination.

Applicants submit that, in the present evaluation, the Examiner's initial burden has not been met because it would be improper to modify primary reference Satoru by Tokito to eliminate the mounting concept in Satoru, wherein the larger display panel slides into a mounting chassis and is attached to the smaller display panel through a series of linkages so that the smaller display panel rotates 90° relative to the larger display as it is removed from the chassis.

To satisfy the plain meaning of the independent claims, the Examiner's initial burden would be to provide motivation to mount the larger display panel of Satoru directly onto a surface of the vehicle.

Applicants submit that such modification of primary reference Satoru would be improper, since it would clearly change the principle of operation of the chassis mounting method of Satoru and would defeat the purpose described in Satoru for that chassis mounting, as described in the English Abstract (“*PURPOSE: To efficiently house display members in the display device and to widen the substantial area of a screen at the time of use.*”).

Therefore, in contrast to the facts of Keller, Applicants submit that the rejection currently of record fails to meet the initial burden of a prima facie obviousness rejection, since a modification to either change the principle of operation or to defeat the purpose of the primary reference is, by the description in MPEP §2143.01, expressly defined as a failure to meet this initial burden:

“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”, citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir., 1984).

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious”, citing In re Ratti, 270 F.2d 810, 123 USPQ 349 CCPA, 1959).

Thus, Applicants submit that, in contrast to *Keller*, the rejection currently of record fails to provide a proper modification of primary reference Satoru and, therefore, fails to meet the initial burden of a *prima facie* rejection.

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

Moreover, in contrast to the facts of *Keller*, the response of record clearly addresses both references cited, rather than merely addressing one reference, to the exclusion of the second reference, as occurred in *Keller*.

Therefore, Applicants submit that the wording from *Keller* is not relevant in the present case, since Applicants are directing the Examiner's attention to the fact that case law indicates that it would be improper to modify Satoru as urged in the rejection currently of record and that, therefore, the present rejection fails to meet the initial burden of a *prima facie* obviousness rejection.

Thus, Applicants respectfully submit that all pending claims are clearly patentable over Satoru by reason of this failure to meet the initial burden.

The Examiner alleges that Satoru, when modified by newly-cited Tokito, renders obvious claims 1 and 13 and, when further modified by Chan, renders obvious claim 6, when further modified by Narayanaswamy, renders obvious claim 12. The Examiner also alleges that, when Satoru/Tokito is modified by Shigemura, claim 21 is rendered obvious, when Satoru/Tokito is further modified by Narayanaswamy, claims 24 and 25 are rendered obvious, when Satoru/Tokito is further modified by Narayanaswamy, claims 14-16 are rendered obvious, when Satoru/Tokito is modified by Ishida, claims 18 and 19 are rendered obvious, and, when Satoru/Tokito is further modified by Narayanaswamy, claim 20 is rendered obvious.

Relative to claims 1 and 13, Applicants again submit that the rejection, wherein the Examiner urges modification by newly-cited Tokito, fails to meet the initial burden of a *prima facie* rejection, since the urged combination would be improper under the holdings in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA, 1959) and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir., 1984), as described in MPEP §2143.01.

That is, the Examiner concedes that Satoru fails to teach or suggest mounting the first panel substantially directly to a surface of the vehicle and introduces newly-cited Tokito to overcome this deficiency. However, Applicants submit that, to one having ordinary skill in the art, the mounting mechanisms in these two prior art references are clearly different.

Applicants further submit that modifying primary reference Satoru to replace the complex mounting mechanism that allows one display unit to slide out of a container-like chassis and the other display panel to rotate as the first display unit moves to become the simple mounting attachment mechanism shown in secondary reference Tokito very clearly changes the principle of operation of Satoru's mounting mechanism and very clearly defeats

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

the purpose explicitly described in the Abstract of Satoru. Such modification is improper under MPEP § 2143.01.

Hence, turning to the clear language of the claims, in Satoru there is no teaching or suggestion of: "... first panel including a first display on a front surface thereof, a back surface of said first panel being substantially directly mountable onto a surface of a vehicle and affixed thereto in a manner that said first display is viewable by a user", as required by claim 1, and claim 13 has similar language.

Therefore, Applicants submit that claims 1, 6, 12-16, 18-21, and 24-25 are clearly patentable over Satoru for this reason alone.

Applicants do not herein repeat the previous arguments of record concerning the impropriety of using secondary references Narayanaswamy and Shigemura by reason of being non-analogous art to primary reference Satoru but again maintain that such combinations are improper because they are non-analogous. Therefore, Applicants again submit that, in contrast to *Keller*, the rejection currently of record involving these two references fails to meet the initial burden of a *prima facie* rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 2, and 6-25, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

RECEIVED
CENTRAL FAX CENTER


FEB 16 2007

Serial No. 10/687,582
Docket No. C14-163313M/YAH (NGB.039Cont)

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 02/16/07


Frederick E. Cooperrider
Registration No. 36,769

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254

CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 this Amendment under 37 CFR §1.111 to Examiner Shapiro on February 16, 2007.


Frederick E. Cooperrider
Reg. No. 36,769